

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Stephane Oberli et al.
Serial No.: 10/516,972 Art Unit: 3723
File Date: July 14, 2005
Title: PIG FOR INSTALLING A CABLE IN A CONDUIT
Confirmation No.: 8739
Examiner: Robert C. Watson
Docket No.: BLAN-37253

PETITION UNDER 37 CFR 1.181

Mail Stop PETITIONS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants hereby request the Director to overrule a holding of non-compliance regarding a Second Amended Appeal Brief filed on November 26, 2008 in the subject application.

Applicants have contemporaneously herewith filed a Third Amended Appeal Brief. Copies of the Second and Third Amended Appeal Briefs are available in the File History of the electronic file for this application.

Applicants, during a long prosecution, introduced language into claim 1 to distinguish cited references. The Examiner contends the claim language is not supported by the specification, making a rejection under 35 USC 112, first paragraph. The applicants contend that the language is

supported by the original specification and drawings and has made several good faith submissions pointing out what they contend is the supporting language and where it is found.

The Examiner's position begs the question. He has made a rejection under 35 USC 112, first paragraph, and the applicants have now filed four briefs arguing the point but have so far been unable to have their remedy of appeal.

The details of applicants Argument can be found on pages 6 and 9 of applicants' Third Appeal Brief, and pages 5 and 6 of applicant's Second Appeal Brief. Also, the two most recent Notifications of Non-Compliance forms received in this case are available in the electronic File History of this application.

The purpose of the requirement of 37 CFR 41.37(c)(1)(v) is "to enable the Board to more quickly determine where the claimed subject matter is described in the application." However, the Examiner is apparently using this rule to improperly prolong the prosecution of the application as evidenced by his repeated efforts to goad the applicants into filing still another RCE. See the Examiner's "explanation in support" in the last two Notifications of Non-Compliant Appeal Brief.

The Examiner's objection to the brief is essentially the same issue as the 35 USC 112, first paragraph issue on appeal.

The Examiner is apparently trying to avoid having this issue fairly decided by the Board by repeatedly raising an

unsupportable formality issue with the brief.

Either the applicants are correct and have support for their claim language, or the Examiner is correct. However, it is not for the Examiner to decide if he is correct, it is the function of the Board of Appeals to decide.

For the above reasons, it is respectfully requested that the Examiner's holding of Non-Compliance be reversed. It is clearly now time for the Examiner to furnish his Answer.

If there are any additional fees resulting from this communication, please charge such fees to Deposit Account No. 16-0820, Order No. BLAN-37253.

Respectfully submitted,

By: 

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January 30, 2009